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09/762,030	03/02/2001	Horst Hintze-Bruning	IN-5453	7425

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EXAMINER

FERGUSON, LAWRENCE D

16

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,030

Applicant(s)

HINTZE-BRUNING ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11,13-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,13-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 14, 2003.

Claim 14 was amended rendering claims 1-4, 6-11, 13-16 and 18 pending.

Claim Rejections – 35 USC § 103(a)

2. Claims 1-4, 6-11, 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0844286.

3. EP '286 discloses filmed powder coatings for substrates made of plastics (abstract) where the coatings are dry and free flowing (page 2, line 17) and have a melt temperature of 200 F (93.33°C) (page 2, lines 44-47). EP '286 discloses thermally cured powder coatings comprising a crosslinker (page 4, lines 36-53) which is a surfacer composition. The reference discloses the coatings as molten film over the substrate with coatings (page 11, lines 21-41) where the substrates are used as furniture (page 12, line 10), which are domestic appliances. The reference further discloses the substrate is a heat sensitive (thermoformable) plastic (thermoplastic) (page 12, line 11). Regarding claim 9, if desired, means this feature does not necessarily have to be met by the reference. With regard to claim 1, Applicant amends to read 'A laminatable film...the claimed film can be rolled up' and 'removable film' in instant claim 9. It is the position of the Examiner that these limitations constitute a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation,

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but only requires the ability to perform said feature. EP '286 does not show that the substrate has the thickness as shown in instant claims 1, 8 and 15. Thickness is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the durability of the film. As such, the thickness is optimizable. It would have been obvious to one of ordinary skill in the art to make the coated film with the limitations of the thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

4. Objection made over claim 14 is withdrawn due to Applicant amending claim 14 to depend from claim 1.

Rejection made under 35 USC 103(a) as being unpatentable over EP 0844286 in view of Craun et al (U.S. 6,184,281) has been carefully considered and the secondary reference has been withdrawn due to Applicant's remarks. Craun does not explicitly teach the removable coatings are recyclable, but that the plastic bottle is recyclable. The primary reference is upheld over the instant claims 1-4, 6-8, 10-11, 13-16 and 18.

Applicant argues amended independent claim 1 is patentable because the cited combination of art fails to provide a prima facie of obviousness. This argument is moot because Craun has been withdrawn from the rejection, because based on Applicant's arguments and the disclosure of Craun, the Craun reference did not teach the removable coatings are recyclable. Applicant argues the cited art fails to disclose a support layer selected from a group consisting of a thermoplastic film, a coated thermoplastic film and a self-supporting paint film. Examiner respectfully disagrees because EP '286 discloses the substrate is a heat sensitive plastic (thermoplastic) (page 12, line 11) film. Applicant argues the reference does not disclose a support layer having a film thickness in the range required by Applicants' claimed invention.


The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. The thickness is optimizable as it directly affects the durability of the film. Applicant argues there is no basis in law for discounting a required performance characteristic of a composition. Examiner acknowledges Applicant's argument and contends that the performance (i.e. lamination and rolling) is not required in the instant claimed invention. Applicant discloses the film is laminatable and can be rolled up, which only requires the ability to perform said feature. EP '286's film has the same ability to perform these functions as Applicant's instant invention. Further, plastic films can be rolled up.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

